



[3510-16-P]

**DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

**37 CFR Part 1**

[Docket No.: PTO-P-2011-0070]

**RIN 0651-AC65**

**Changes to Implement the Prioritized Examination for Requests for Continued Examination**

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Final rule.

**SUMMARY:** The Leahy-Smith America Invents Act includes provisions for prioritized examination of patent applications. The United States Patent and Trademark Office (Office) implemented the Leahy-Smith America Invents Act prioritized examination provision following the prioritized examination track (Track I) of the proposed 3-Track examination process in a previous final rule. The final rule was made applicable to newly filed patent applications. In order to provide patent applicants with the flexibility to

accelerate processing of their applications in which a request for continued examination has been filed, the Office is now permitting applicants to request prioritized examination for applications after the filing of a request for continued examination.

**DATES:** Effective Date: The changes in this final rule are effective on [insert date of publication in the Federal Register].

Applicability Date: The changes in this final rule are applicable to any patent application in which a proper request for continued examination has been filed before, on, or after [insert date of publication in the Federal Register].

**FOR FURTHER INFORMATION CONTACT:** By telephone to Eugenia A. Jones, at (571) 272-7727, Kathleen Kahler Fonda, at (571) 272-7754, or Michael T. Cygan, at (571) 272-7700; or by mail addressed to: United States Patent and Trademark Office, Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Eugenia A. Jones, Kathleen Kahler Fonda or Michael T. Cygan.

**SUPPLEMENTARY INFORMATION:** Under the procedure set forth in this final rule, once the application is accorded special status after the filing of a request for continued examination it will be placed on the examiner's special docket throughout its entire course of continued prosecution before the examiner until a final disposition is reached in the application. The goal for handling applications under prioritized

examination for request for continued examination is to, on average, provide a final disposition within twelve months of prioritized status being granted. For purposes of the twelve-month goal, “final disposition” can be any of the following: (1) mailing of a notice of allowance; (2) mailing of a final Office action; (3) filing of a notice of appeal; (4) completion of examination as defined in 37 CFR 41.102; (5) filing of a subsequent request for continued examination; or (6) abandonment of the application. An application under prioritized examination, however, would not be accorded special status throughout its entire course of appeal or interference before the BPAI, or after the filing of a subsequent request for continued examination.

Filing an amendment to the application which results in more than four independent claims, more than thirty total claims, or a multiple dependent claim will terminate the prioritized examination. Upon termination of prioritized examination, the application will be removed from the examiner’s special docket and placed on the examiner’s regular docket in accordance with its stage of prosecution. As the termination of prioritized examination does not cause the prioritized examination fee to have been paid by mistake or in an amount in excess of that required, the termination of prioritized examination will not entitle the applicant to a refund of the prioritized examination fee. See 35 U.S.C. 42(d) and § 1.26(a) (permits refunds only for fees “paid by mistake or any amount paid in excess of that required”).

As discussed previously, the submission of an amendment resulting in more than four independent claims or more than thirty total claims is not prohibited, but simply terminates the prioritized examination. Thus, upon mailing of a final rejection (at which point prioritized examination is terminated), applicants may amend the claims to place them in independent form where dependent claims were found allowable, or add new claims, subject only to the limitations applicable to any application under final rejection. See 37 CFR 1.116. Similarly, upon mailing of a notice of allowance, applicants may submit amendments to the claims, again subject only to the limitations applicable to any application that has been allowed. See 37 CFR 1.312.

The requirements for requesting prioritized examination after the filing of a request for continued examination are summarized below. A patent application may be granted prioritized examination status under the following conditions:

- (1) The request for continued examination must be in an original utility or plant nonprovisional application filed under 35 U.S.C. 111(a) or that has entered the national stage under 35 U.S.C. 371.
- (2) The request for prioritized examination must be filed via the Office's electronic filing system (EFS-Web), except in a plant application for which the request must be filed in paper (MPEP 502.05(II)(B)) prior to the mailing of a first Office action after the filing of the request for continued examination under 37 CFR 1.114. The request for prioritized

examination may either be filed concurrently with, or subsequently to, the filing of a request for continued examination.

(3) At the time of the request for prioritized examination, the application must contain or be amended to contain no more than four independent claims and no more than thirty total claims. In addition, the application must not contain any multiple dependent claims. If an amendment is filed in an application that has been granted prioritized examination that results in more than four independent claims or thirty total claims, or a multiple dependent claim, then prioritized examination will be terminated.

(4) The request for prioritized examination must be accompanied by the prioritized examination fee set forth in 37 CFR 1.17(c), the processing fee set forth in 37 CFR 1.17(i), and if not previously paid, the publication fee set forth in 37 CFR 1.18(d). Applicants are advised to use the certification and request form PTO/SB/424 which is available on EFS-Web.

(5) The Leahy-Smith America Invents Act currently limits the number of requests for prioritized examination under § 1.102(e) that the Office may accept to a maximum of 10,000 per fiscal year. This includes both requests for prioritized examination for initial examination (37 CFR 1.102(e)(1)) and requests for prioritized examination after filing of a request for continued examination (37 CFR 1.102(e)(2)).

## **Discussion of Specific Rules**

Title 37 of the Code of Federal Regulations, Part 1, is proposed to be amended as follows:

Section 1.102: Section 1.102(e) is revised to set out the general requirements for prioritized examination and the specific requirements for prioritized examination for initial examination (Track I) (37 CFR 1.102(e)(1)) and for prioritized examination after the filing of a request for continued examination (37 CFR 1.102(e)(2)).

Section 1.102(e) provides that a request for prioritized examination under § 1.102(e) must comply with the requirements of § 1.102(e) and be accompanied by the prioritized examination fee set forth in § 1.17(c), the processing fee set forth in § 1.17(i), and the publication fee set forth in § 1.18(d). Section 1.102(e) also provides that an application for which prioritized examination has been requested may not contain or be amended to contain more than four independent claims, more than thirty total claims, or any multiple dependent claim. Section 1.102(e) also provides that prioritized examination under this paragraph will not be accorded to international applications that have not entered the national stage under 35 U.S.C. 371, design applications, reissue applications, provisional applications, or reexamination proceedings. Finally, § 1.102(e) provides that a request for prioritized examination must also comply with the requirements of § 1.102(e)(1) or § 1.102(e)(2).

Section 1.102(e)(1) provides that a request for prioritized examination may be filed with an original utility or plant nonprovisional application under 35 U.S.C. 111(a) that is complete as defined by § 1.51(b), with any fees due under § 1.16 paid on filing. If the application is a utility application, it must be filed via the Office's electronic filing system (EFS-Web). The request for prioritized examination in compliance with § 1.102(e)(1) must be present upon filing. The discussion in the final rule to implement prioritized examination for initial examination (Track I) (Changes to Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures under the Leahy-Smith America Invents Act, 76 FR 59050 (Sept. 23, 2011)) remains applicable to request for prioritized examination under § 1.102(e)(1).

Section 1.102(e)(2) provides that a request for prioritized examination may be filed with or after a request for continued examination in compliance with § 1.114. Only a single such request for prioritized examination under § 1.102(e)(2) may be granted in an application. If the application is a utility application, the request must be filed via the Office's electronic filing system (EFS-Web). The request must be filed before the mailing of the first Office action after the filing of the request for continued examination under § 1.114. The request must be accompanied by the prioritized examination fee set forth in § 1.17(c), the processing fee set forth in § 1.17(i), and if not already paid, the publication fee set forth in § 1.18(d).

## **Rule Making Considerations:**

### **A. Administrative Procedure Act:**

This final rule implements prioritized examination for applications after the filing of a request for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114. The changes in this final rule that implement the fee for prioritized examination and requirements specified in section 11(h) of the Leahy-Smith America Invents Act are merely interpretative. See Gray Panthers Advocacy Comm. v. Sullivan, 936 F.2d 1284, 1291-1292 (D.C. Cir. 1991) (regulation that reiterates statutory language does not require notice and comment procedures); See Nat'l Org. of Veterans' Advocates v. Sec'y of Veterans Affairs, 260 F.3d 1365, 1375 (Fed. Cir. 2001). The additional requirements (e.g., filing via the Office's electronic filing system (EFS-Web)) merely specify the procedures that apply to applications for which an applicant has requested prioritized examination and are thus procedural and not substantive. See JEM Broad. Co. v. FCC, 22 F.3d 320, 326 (D.C. Cir. 1994) ("[T]he critical feature of the procedural exception [in 5 U.S.C. 553(b)(A)] is that it covers agency actions that do not themselves alter the rights or interests of parties, although [they] may alter the manner in which the parties present themselves or their viewpoints to the agency") (quoting Batterton v. Marshall, 648 F.2d 694, 707 (D.C. Cir. 1980)). Specifying the procedures for according prioritized examination for an application in which a request for continued examination has been made concerns only the manner in which applicants interact with the Office and does not change the substantive rights (condition of patentability) of any patent applicant. See



Bachow Communications, Inc. v. F.C.C., 237 F.3d 683 (D.C. Cir. 2001) (rule permitting or suspending amendments to applications was procedural).

Accordingly, prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553(b)(A) or any other law. See Cooper Techs. Co. v. Dudas, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), do not require notice and comment rule making for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice.”) (quoting 5 U.S.C. 553(b)(A)). In addition, thirty-day advance publication is not required pursuant to 5 U.S.C. 553(d) or any other law. See 5 U.S.C. 553(d) (requiring thirty-day advance publication for substantive rules).

**B. Regulatory Flexibility Act:** As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a regulatory flexibility analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 et seq.) is required. See 5 U.S.C. 603.

**C. Executive Order 12866 (Regulatory Planning and Review):** This rule making has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

**D. Executive Order 13563 (Improving Regulation and Regulatory Review):** The Office has complied with Executive Order 13563 (Jan. 18, 2011). Specifically, the Office has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector and the public as a whole, and provided on-line access to the rule making docket; (7) attempted to promote coordination, simplification and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

**E. Executive Order 13132 (Federalism):** This rule making does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

**F. Executive Order 13175 (Tribal Consultation):** This rule making will not: (1) have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a

tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

**G. Executive Order 13211 (Energy Effects):** This rule making is not a significant energy action under Executive Order 13211 because this rule making is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

**H. Executive Order 12988 (Civil Justice Reform):** This rule making meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

**I. Executive Order 13045 (Protection of Children):** This rule making does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

**J. Executive Order 12630 (Taking of Private Property):** This rule making will not effect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

**K. Congressional Review Act:** Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.), prior to issuing any final rule, the United States Patent and Trademark Office will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this notice are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this notice is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

**L. Unfunded Mandates Reform Act of 1995:** The changes set forth in this notice do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

**M. National Environmental Policy Act:** This rule making will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 et seq.

**N. National Technology Transfer and Advancement Act:** The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rule making does not contain provisions which involve the use of technical standards.

**O. Paperwork Reduction Act:** This rule making implements a prioritized examination process. The primary impact on the public of this change is that applicants will have the option to request prioritized examination by paying appropriate fees, filing a request via the Office's electronic filing system (EFS-Web), and limiting their applications to four independent claims and thirty total claims with no multiple dependent claims.

An applicant who wishes to participate in the program must submit a certification and request to participate in the prioritized examination program, preferably by using Form PTO/SB/424. The Office of Management and Budget (OMB) has determined that, under 5 CFR 1320.3(h), Form PTO/SB/424 does not collect "information" within the meaning of the Paperwork Reduction Act of 1995. Therefore, this rule making does not impose additional collection requirements under the Paperwork Reduction Act which are subject to further review by OMB.

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

**List of Subjects in 37 CFR Part 1**

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small Businesses.

For the reasons set forth in the preamble, 37 CFR part 1 is amended as follows:

**PART 1 - RULES OF PRACTICE IN PATENT CASES**

1. The authority citation for 37 CFR Part 1 continues to read as follows:

**Authority:** 35 U.S.C. 2(b)(2).

2. Section 1.102 is amended by revising paragraph (e) to read as follows:

**§ 1.102 Advancement of examination.**

\* \* \* \* \*

(e) A request for prioritized examination under this paragraph must comply with the requirements of this paragraph and be accompanied by the prioritized examination fee set forth in § 1.17(c), the processing fee set forth in § 1.17(i), and if not already paid, the publication fee set forth in § 1.18(d). An application for which prioritized examination has been requested may not contain or be amended to contain more than four independent claims, more than thirty total claims, or any multiple dependent claim. Prioritized examination under this paragraph will not be accorded to international applications that have not entered the national stage under 35 U.S.C. 371, design applications, reissue applications, provisional applications, or reexamination proceedings. A request for prioritized examination must also comply with the requirements of paragraph (e)(1) or paragraph (e)(2) of this section.

(1) A request for prioritized examination may be filed with an original utility or plant nonprovisional application under 35 U.S.C. 111(a) that is complete as defined by § 1.51(b), with any fees due under § 1.16 paid on filing. If the application is a utility application, it must be filed via the Office's electronic filing system. The request for prioritized examination in compliance with this paragraph must be present upon filing of the application.

(2) A request for prioritized examination may be filed with or after a request for continued examination in compliance with § 1.114. If the application is a utility application, the request must be filed via the Office's electronic filing system. The request must be filed before the mailing of the first Office action after the filing of the

request for continued examination under § 1.114. Only a single such request for prioritized examination under this paragraph may be granted in an application.

Date: \_December 7, 2011\_

David J. Kappos

Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

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